

## REMARKS

Claims 1-7 and 36-40 were examined. Claim 2 is canceled. Claims 1, 3-7 and 36-40 remain in the Application.

The Patent Office rejects claim 2 under 35 U.S.C. §112, second paragraph. The Patent Office rejects claims 1-5 and 36-40 under 35 U.S.C. §103(a).

A. 35 U.S.C. §112, Second Paragraph: Rejection of Claim 2

The Patent Office rejects claim 2 under 35 U.S.C. §112, second paragraph. Claim 2 is canceled rendering the rejection moot.

B. 35 U.S.C. §103(a): Rejection of Claims 1-5 & 36-38

The Patent Office rejects claims 1-5 and 36-38 under 35 U.S.C. §103(a) as obvious over U.S. Patent Application No. 2005/0042369 of Mao et al. (Mao) in view of U.S. Patent No. 3,859,130 of Parker et al. (Parker) and U.S. Patent No. 6,737,939 of Hoppe et al. (Hoppe).

Mao describes a method of forming a thin film catalyst for carbon nanotubes growth. The method involves depositing nano particles with an average size of about 100 nanometers and coating the particles with a metal film. See ¶¶ [0019-0020]. Parker describes a method of preparing magnetic recording media. While precautions were taken to avoid exposing the cobalt particles to oxygen, the resulting particles from Parker exhibited from about 0.8 to 10 percent oxygen content, as well as phosphorous and boron content. See col. 3, lines 22-25.

Hoppe is cited for disclosing forming nanotubes on a semiconductor substrate.

Claims 1-5 and 36-38 are not obvious over the cited references, because the cited references fail to describe a motivation or a prediction for forming a metal particle of a size suitable for use as a catalyst in forming a nanotube by an electroless process in a bath. The Patent Office believes it would be obvious to use the process of Parker to form the particles used in Mao. However, it appears from the discussion in Parker that the elemental content of the particles formed by Parker cannot be well-controlled. Thus, it does not necessarily follow that Parker may be combined with Mao.

For the above stated reasons, Applicant respectfully requests that the Patent Office withdraw the rejection to claims 1-5 and 36-38 under 35 U.S.C. §103(a).

C. 35 U.S.C. §103(a): Rejection of Claims 6-7 & 39-40

The Patent Office rejects claims 6-7 and 39-40 under 35 U.S.C. §103(a) over Mao, in view of Parker and Hoppe and further in view of U.S. Patent Application No. 2005/0089467 of Grill et al. (Grill) and U.S. Patent No. 6,838,354 of Goldberg et al. (Goldberg).

Grill is cited for disclosing catalytic particles of transition metals including cobalt, nickel and tungsten. Goldberg is cited for teaching reducing agent of sodium or ammonium hypophosphate.

Claims 6-7 and 39-40 depend from claim 1 and therefore contain all the limitations of that claim. For at least the reason stated above with respect to claim 1, claims 6-7 and 39-40 are not obvious over the cited references.

Applicant respectfully requests that the Patent Office withdraw the rejection to claims 6-7 and 39-40 under 35 U.S.C. §103(a).

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.

Nedy Calderon 6/24/08  
Nedy Calderon Date